

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THEO THONNES

Appeal No. 2001-1608
Application 08/619,699

HEARD: November 29, 2001

Before MCQUADE, NASE, and BAHR, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Theo Thonnes appeals from the final rejection of claims 4 and 6 through 10, all of the claims pending in the application.

THE INVENTION

The invention relates to a threaded fastener which is defined in representative claim 4 as follows:

4. A fastener having a body unitarily formed with:
at least one screwthread;
a pair of concentric faceted tool-fitting formations of different sizes, one of the formations corresponding to a

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standard metric wrench size and the other of the formations corresponding to a standard English-system wrench size; and a step between the formations.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Becker 1980	4,189,976	Feb. 26,
Warner 1981	4,267,870	May 19,
Toth et al. (Toth) 1994	5,302,069	Apr. 12,
Anapliotis, European Patent Document ¹ 1986	172,130	Feb. 19,

THE REJECTIONS

Claims 4, 6, 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Toth.

Claims 4, 6, 7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anapliotis.

¹ An English language translation of this reference, prepared on behalf of the United States Patent and Trademark Office, is appended hereto.

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Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Toth in view of either Becker or Warner.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 10 and 12) and to the examiner's answer (Paper No. 11) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

DISCUSSION

Toth and Anapliotis, the examiner's primary references, disclose screw threaded fasteners having a pair of concentric faceted tool-fitting formations of different sizes separated by a step.

The Toth fastener is a wheel nut insert 24 comprising a central internally threaded bore 34 and first and second external hexagonal portions 30 and 32 separated by a shoulder 36. The operating width 40 of the first hexagonal portion 30 is smaller than the operating width 42 of the second hexagonal

portion 32. Toth teaches that these operating widths can be sized under either the metric system or the English system, with one of the widths having a standard size for accommodating a standard size socket wrench (see Toth at column 4, line 47 et seq.).

The Anapliotis fastener is a bone screw 1 comprising a shaft 3 bearing external threads 2 and a head 4 having hexagonal recesses 6 and 7 separated by a step (see Figure 1). The recess 6 has a diameter of 8 mm corresponding to a wrench width of SW 5 and the recess 7 has a diameter of 5 mm corresponding to a wrench width of SW 3.5 (see page 9 in the translation).

In applying each of these references against independent claim 4, the examiner concedes that neither meets the claim limitation requiring differently sized formations with "one of the formations corresponding to a standard metric wrench size and the other of the formations corresponding to a standard English-system wrench size." Nonetheless, the examiner concludes that "it would have been an obvious matter of design choice to alter the sizes of the [Toth and Anapliotis] formations in order to correspond with standard metric and

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English-system wrench sizes, since such a modification would have involved a mere change in the size of a component" (answer, page 4; and pages 4 and 5). The examiner adds that the proposed modification of each prior art fastener would "provide simply a more versatile, economical, and compatible fastener which affords a greater degree of user convenience" (answer, page 6).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

The examiner's position that the differences between the subject matter recited in claim 4 and each of the Toth and Anapliotis fasteners involve mere matters of size inordinately oversimplifies these differences. As aptly pointed out in the reply brief, the appellant "is not claiming two different formations of two different sizes, but two different coaxial

tool-engaging formations conforming to two different measurement systems. The distinction is clear. Admittedly the formations must be different sizes, but [it] is the conformation to different measurement systems and not the relative sizes that is critical" (page 2). Neither Toth nor Anapliotis provides any teaching or suggestion of a fastener having differently sized formations with one corresponding to a standard metric wrench size and the other corresponding to a standard English-system wrench size. The rationale advanced by the examiner to overcome these deficiencies has no factual basis, and amounts to an impermissible hindsight reconstruction of the appellant's invention. Neither Becker nor Warner, alternatively applied in combination with Toth to reject dependent claim 10, cures the shortcomings in the examiner's evidence.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejections of claim 4 and dependent claims 6, 8 and 9 as being unpatentable over Toth, of claim 4 and dependent claims 6, 7 and 9 as being unpatentable over Anapliotis, and of dependent claim 10 as being unpatentable over Toth in view of either Becker or Warner.

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SUMMARY

The decision of the examiner to reject claims 4 and 6
through 10 is reversed.

REVERSED

JOHN P. MCQUADE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
)	
)	APPEALS AND
JEFFREY V. NASE)	
Administrative Patent Judge)	INTERFERENCES
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JENNIFER D. BAHR)	
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